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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/490,622	01/24/2000	Stuart Edwards	STUA0010	7398

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EXAMINER	
THISSELL, JEREMY	
ART UNIT	PAPER NUMBER
3763	

DATE MAILED: 04/24/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/490,622

Applicant(s)

EDWARDS, STUART

Examiner

Jeremy T. Thissell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 4,5,7,9-13,15-17,21,22 and 38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6,8,14,18-20 and 23-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) Z.

- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Election/Restrictions

Applicant's election of Species A, G, M, Q, and T in Paper No. 9 is acknowledged. Although applicant did not distinctly and specifically point out the supposed errors in the restriction requirement in their response filed 6 February 2003, the full election was made in a telephone conversation with Michael Glenn on 11 March 2003 after some clarification, and thus, has been treated as an election **WITH traverse**. **Accordingly, Applicant may still set forth grounds of traversal in the response to this office action.**

Applicant indicated that these Species are set forth by claims 2, 8, 14, 20, and 37. However, the examiner also found it appropriate to examine claims 3 and 6, since the subject matter therein does not conflict with that in elected claim 2. Accordingly, claims 1-3, 6, 8, 14, 18, 19, 20, 23-37 are examined herein. Claims 4, 5, 7, 9-13, 15-17, 21, 22, and 38 are withdrawn from further consideration as being drawn to non-elected species.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

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granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 6, 8, 14, 25-32, and 34-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Slepian et al (US 5,674,287).

Slepian teaches all the claimed subject matter including local heating of an infused saline that is delivered directly from the catheter or through a "leaky balloon," as well as temperature control feedback. Col. 9, lines 53-66; col. 10, line 46; col. 14, line 37.

Claims 1, 2, 8, 14, 20, and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Swartz et al (US 5,938,660).

Swartz teaches all the claimed subject matter including heating a saline solution (col. 11, lines 44-54).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz in view of Goffinet (WO 85/02779).

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Swartz teaches all the claimed subject matter except for the tissue being cancerous, engorged, inflamed, or infected. Goffinet teaches ablation (like Swartz) of malignant (cancerous) tumors. (page 1, line 2). It would have been obvious to one of ordinary skill in the art that a tissue to be ablated by Swartz would include cancerous tissue as taught by Goffinet, since ablation of cancerous tissue is well-known in the art, as demonstrated by Goffinet.

Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slepian in view of Guglielmi (US 5,916,235).

Slepian teaches all the claimed subject matter except for shrinking the lumen down to a selected dimension, more specifically the normal dimension. Guglielmi teaches the shrinkage of enlarged body lumens by using heat. (col. 4, lines 31-32). It would have been obvious to use the body lumen heating procedure in Slepian for shrinking an enlarged body lumen as well, such as taught in Guglielmi, since such a treatment is well-known in the art, as taught by Guglielmi. One of ordinary skill in the art would have found it further obvious that the selected dimension would be the normal dimension of the body lumen, since returning the body to its normal condition/functional capacity is the goal of most medical procedures.

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Slepian in view of Gencheff et al (US 5,423,744).

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Slepian teaches all the claimed subject matter except for promoting epithelial growth. Gencheff teaches introduction of a medicinal agent and energy such that it promotes endothelial cell growth. (col. 6, lines 1-3). Endothelial cells are a kind of epithelial cells. It would have been obvious to one of ordinary skill in the art that the promotion of endothelial cells, as in Gencheff, is an important part of treatment of body lumens, and that it would be obvious to make it a part of Slepian's treatment.

Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz in view of Lesh (US 5,971,983).

Swartz teaches all the claimed subject matter except for pacing. Lesh teaches treatment of the heart using an ablation catheter and a pacing device. It would have been obvious to perform the heart tissue ablation of Swartz and include the pacing device of Lesh, particularly since Swartz is concerned with the muscle stimulating electrical impulses of the heart.

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Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy T. Thissell whose telephone number is (703) 305-5261. The examiner can normally be reached on 8:30-7:00 Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached at (703) 308-3552. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

jt
April 18, 2003



MICHAEL J. HAYES
PRIMARY EXAMINER